# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/819,459 | 03/28/2001 | Toshihiko Ueno | JP9 2000 0380US1 | 3433 |

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| EXAMINER |
|---|
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/819,459 | UENO ET AL. |
| | **Examiner** | **Art Unit** | |
| | Nga B. Nguyen | 3692 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>06 February 2007</u>.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☒ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

    *The Certified copy of the priority document JAPAN 2000-91794 03/29/2000 has NOT been received.*

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

## DETAILED ACTION

1.      A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection.  Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114.  Applicant's submission filed on

February 6, 2007 has been entered.

2.      Claims 1-28 are pending in this application.


### *Response to Arguments/Amendment*

3.      Applicant's arguments with respect to claims 1-28 have been considered but

are moot in view of new grounds of rejection.


### *Claim Rejections - 35 USC § 102*

4.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.      Claims 1-6, 8, 9, 11-18, 20, 21, and 24-28 are rejected under 35 U.S.C. 102(e) as

being anticipated by Webb et al (hereinafter Webb), U.S. Patent No. 6,877,661.

Regarding to claim 1, Webb discloses a processing system comprising:

a data management server for storing registration information about a customer

(figure 7 and column 10, lines 30-65, *the data center 310*);

a customer communication terminal adapted for data communication with said

data management server and for outputting information for identifying a customer (figure

7 and column 9, lines 55-65, *the cellular phone 302*); and

a process execution terminal for receiving said information for identifying the

customer from said customer communication terminal and executing a process for said

customer (figure 7, *Cash register 326*), wherein:

said process execution terminal provides said information to said data

management server when receiving said information for identifying the customer

(column 11, lines 55-65, the cash register 326 queries the data center 310 to determine

whether or not a valid coupon relevant to the currently scanned list of goods exists for

the identified user);

said data management server identifies the customer based on said information

provided from said process execution terminal, generates reply information based on

said registration information about said customer, and provides said reply information to

said process execution terminal (column 12, lines 5-30, the data center 310 matches

the list against all of the existing coupon in its database for the particular user and send

a discount code bad to the cash register 326); and

said process execution terminal executes a process for said customer based on

said reply information when receiving said reply information (column 12, lines 25-30, the

cash register 326 identifies the discount code and updates the bill, and the user can then pay the bill to completer the transaction).

wherein the information for identifying the customer and the registration information about the customer is associated with each other only at the data management server, the data management server being different than the process execution terminal that receives the information for identifying the customer (figure 8 and column 17, line 40-column 18, line 50, the data center 310 includes is database servers store User Data and Coupon Data; the data center 310, different than the cash register 326)

Regarding to claim 2, Webb further discloses said data management server sends said information for identifying the customer to said customer communication terminal when said customer communication terminal accesses said data management server (column 14, lines 10-25, the data center 310 send the barcode coupon to the user's cellular phone 302); and said customer communication terminal receives said information sent from said data management server and outputs said information to said process execution terminal (column 14, lines 25-35, the user gives the cellular phone 302 with displayed barcode to the store clerk to be scanned at the cash register 326).

Regarding to claim 3, Webb further discloses wherein said data management server inquires to an external credit institution about a credit card number for payment and provides information obtained from said external credit institution as said reply information if said registration information is the number of a card for payment (column 16, lines 1-12).

Regarding to claim 4, Webb further discloses wherein said data management server information communicates an amount billed included in said registration information as said reply if said registration information is information about billing issued to said customer (column 16, lines 40-55).

Regarding to claim 5, Webb further disclose wherein: said data management server determines whether an admission ticket is valid or not and provides the determination as said reply information, if said registration information is information about said admission ticket, and said process execution terminal outputs information indicating whether said customer is granted admittance or not based on said reply information from said data management server (column 20, lines 15-27).

Regarding to claim 6, Webb discloses a processing system comprising:

a data management server for associating an identification code identifying a customer with registration information registered for said customer and sending mark data representing said identification code to a customer communication terminal (figure 7 and column 10, lines 30-65, *the data center 310*; column 14, lines 10-25, the data center 310 send the barcode coupon to the user's cellular phone 302); and

a process execution terminal adapted for data communication with said data management server, said process execution terminal having a mark reader for reading a mark displayed on the display of said customer communication terminal based on said mark data, and executing a process for said customer based on said read mark data (figure 7, *Cash register 326*; column 14, lines 25-35, the user gives the cellular phone

302 with displayed barcode to the store clerk to be scanned at the cash register 326),

wherein:

said process execution terminal sends said mark data read by said mark reader

to said data management server (column 11, lines 55-65, the cash register 326 queries

the data center 310 to determine whether or not a valid coupon relevant to the currently

scanned list of goods exists for the identified user);

said data management server identifies said registration information associated

with said identification code based on said mark data sent from said process execution

terminal, generates instruction information indicating a process to be performed for said

customer based on said registration information, and sends said instruction information

to said process execution terminal (column 12, lines 5-30, the data center 310 matches

the list against all of the existing coupon in its database for the particular user and send

a discount code back to the cash register 326), and

said process execution terminal, which receives said instruction information,

executes the process for the customer based on said instruction information (column

12, lines 25-30, the cash register 326 identifies the discount code and updates the bill,

and the user can then pay the bill to completer the transaction).

wherein the information for identifying the customer and the registration

information about the customer is associated with each other only at the data

management server (figure 8 and column 17, line 40-column 18, line 50, the data center

310 includes database servers store User Data and Coupon Data).

Regarding to claim 8, Webb further discloses wherein said mark data sent to said

customer communication terminal from said data management server is invalidated

after the completion of the process in said process execution terminal (column 12, lines

12-17).

Regarding to claim 9, Webb further discloses wherein said data management

server sets information different from a payment card number held by said customer or

an account number of said customer as said identification code (column 16, lines 13-

30).

Regarding to claim 11, Webb discloses a server comprising:

data storage for associating an identification code identifying a customer with

registration information registered for said customer and storing said identification code

and said registration information (figure 7 and column 10, lines 30-65, *the data center*

*310*; column 14, lines 10-25, the data center 310 send the barcode coupon to the user's

cellular phone 302);

a customer communication section capable of data communication with a

customer communication terminal (figure 7 and column 9, lines 55-65, *the cellular*

*phone 302*); and

a code issuing section for sending said identification code to said customer

communication terminal through said customer communication section in response to a

received request (column 14, lines 10-25, the data center 310 send the barcode coupon

to the user's cellular phone 302).

wherein the information for identifying the customer and the registration

information about the customer is associated with each other only at the data

management server (figure 8 and column 17, line 40-column 18, line 50, the data ·

center 310 includes is database servers store User Data and Coupon Data).

Regarding to claim 12, Webb further discloses wherein said code issuing section

sends said identification code in barcode data form (column 10, lines 25-30).

Regarding to claim 13, Webb further discloses wherein said data storage

associates a password set by said customer with said identification code and stores

said password and said identification code; and said code issuing section verifies

whether a password, input from said customer communication terminal, matches said

password stored in said data storage, and issues said identification code (column 16,

lines 5-12).

Regarding to claim 14, Webb further discloses further comprising: a process

executer communication section capable of data communication with a process

execution terminal for execution of a process requested by said customer; and all

instruction information issuing section for generating instruction information indicating

the process to be performed by said process execution terminal for said customer

based on said registration information associated with said identification code when

receiving said identification code issued by said code issuing section through said

process executer communication section from said process execution terminal, and

providing said instruction information to said process execution terminal through said

process executer communication section (column 12, lines 30-65).

Regarding to claim 15, Webb further discloses wherein said data storage stores as said registration information a number of membership points held by said customer; said instruction information issuing section informs a process execution terminal of the number of membership points as said instruction information when receiving said identification code and stores a new number of membership points in said data storage when receiving a new number of membership points changed from said number of membership points from said process execution terminal (column 19, lines 40-55 and column 23, lines 8-10; membership program, membership card).

Regarding to claim 16, Webb further discloses a process confirmation section for confirming whether a process requested by said process execution terminal should be performed or not with said customer communication terminal before said instruction information issuing section provides said instruction information to said process execution terminal (column 12, lines 5-30).

Regarding to claim 17, Webb discloses a processing terminal comprising:

a code receiver for receiving an identification code, output from a communications terminal of a customer, for identifying said customer (column 11, lines 35-37, the barcode displayed on the customer's phone is scanned at the ash register); and

process information output logic for inquiring of all external server about said identification code received by said code receiver and outputting process information for said customer based on a reply from said external server about said identification code (column 11, lines 55-65, the cash register computer queries the data center to

determine whether or not a valid coupon relevant to the currently scanned list of goods exists for the identified user).

wherein the information for identifying the customer and the registration information about the customer is associated with each other only at the data management server (figure 8 and column 17, line 40-column 18, line 50, the data center 310 includes is database servers store User Data and Coupon Data).

Regarding to claim 18, Webb further discloses wherein said code receiver receives said identification code data from said customer communications terminal by communication wireless (column 11, lines 37-55).

Regarding to claim 20, Webb further discloses wherein said process information output logic displays an amount claimed from said customer based on a reply provided by said external server about said identification code (column 12, lines 18-30).

Regarding to claim 21, Webb discloses a communication terminal comprising:

a display for displaying an image (figure 7 and column 9, lines 55-65, *the cellular phone 302*; column 11, lines 13-15, a barcode is displayed on the phone's LCD display).

a communicator capable of accessing an external server (figure 7, Retailer's IT 322 infrastructure is capable of accessing Data Center 310);

a code issue requester for accessing an external server through said communicator and requesting said external server to issue a process code (column 11, lines 24-37, the data center 310 send an initial barcode to the user wireless device 302); and

a display controller for causing said display to display said process code, wherein

said process code is issued from said external sever and received through said

communicator (column 11, lines 13-15, a barcode is displayed on the phone's LCD

display);

wherein the external server issues the process code by associating information

for identifying a customer using the communication terminal with registration information

about the customer and wherein the information for identifying the customer and the

registration information about the customer is associated with each other only at the

data external server (figure 8 and column 17, line 40-column 18, line 50, the data

center 310 includes is database servers store User Data and Coupon Data).

Claims 24-26 contain similar limitations found in claims 1, 11, 17 above, therefore,

are rejected by the same rationale.

Claims 27-28 contain similar limitations found in claims 1,17 above, therefore, are

rejected by the same rationale.

### Claim Rejections - 35 USC § 103

6.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.      Claims 7, 10, 19, 22, and 23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Webb et al (hereinafter Webb), U.S. Patent No. 6,877,661.

Regarding to claim 7, Webb does not disclose wherein said mark is a two-dimensional barcode. However, Webb discloses wherein said mark is a one-dimensional barcode (figure 1). Moreover, a two-dimensional barcode is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Webb to incorporate the well-known feature above for the purpose of providing the ability to scan the coupon with different type of barcode, e.g. two-dimensional barcode.

Regarding to claim 10, Webb does not disclose wherein said data management server sets a telephone number of said customer communication terminal as said identification code. However, setting a telephone number of said customer communication terminal, as said identification code is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Webb to adopt the well-known feature above for the purpose of providing more convenient in processing purchase transaction using customer communication terminal.

Regarding to claim 19, Webb further discloses wherein said code receiver comprises a barcode reader for reading a displayed on the display of said customer communications terminal (column 11, lines 35-37, the barcode displayed on the customer's phone is scanned at the cash register). Webb does not disclose reading a two-dimensional barcode. However, reading a two-dimensional barcode is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Webb to incorporate the well-known feature

above for the purpose of providing the ability to scan the coupon with different type of

barcode, e.g. two-dimensional barcode.

Regarding to claims 22-23, Webb further discloses wherein said barcode

displayed on said display is associated with information on billing issued to a customer

holding said communications terminal (column 16, lines 5-12) and wherein said barcode

displayed on said display includes data for an admission ticket (column 20, lines 15-27).

Webb does not disclose displaying two-dimension barcode. However, displaying two-

dimensional barcode is well known in the art. Therefore, it would have been obvious to

one with ordinary skill in the art at the time the invention was made to modify Webb to

incorporate the well-known feature above for the purpose of providing the ability to scan

the coupon with different type of barcode, e.g. two-dimensional barcode.


### *Conclusion*

8.      Claims **1-28** are rejected.

9.      The prior arts made of record and not relied upon is considered pertinent to

applicant's disclosure:

Gobburu et al. (US 6,736,322) disclose method and apparatus for acquiring,

maintaining, and using information to be communicated in barcode form with a mobile

communication device.

McMahon et al. (US 5,789,732) disclose portable data module and system for

consumer transactions.

10.     Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571) 272-6777.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11.     Any response to this action should be mailed to:

> Commissioner of Patents and Trademarks
>
> C/o Technology Center 3600
>
> Washington, DC 20231

Or faxed to:

> (571) 273-8300 (for formal communication intended for entry),

or

> (571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).

NGA NGUYEN
PRIMARY EXAMINER

April 24, 2007